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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/005,012 | 12/04/2001 | Miki Abe | 09812.0692-00000 | 9706 |

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| EXAMINER |
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CERVETTI, DAVID GARCIA

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| ART UNIT | PAPER NUMBER |
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2136

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 03/05/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/005,012

Applicant(s)

ABE ET AL.

Examiner

David G. Cervetti

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/21/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments filed December 13, 2006, have been fully considered.
2. Claims 1-25 are pending and have been examined.

Response to Amendment

3. Applicant's arguments with respect to the prior art have been considered but are moot in view of the new ground(s) of rejection.
4. The rejection of claims 1-23 and 25 under 35 U.S.C. 112, second paragraph, is withdrawn.

Allowable Subject Matter

5. The indicated allowability of claims 1-23 and 25 is withdrawn in view of the newly discovered reference(s) to Tagawa et al. (US Patent 7,096,504, hereinafter Tagawa). Rejections based on the newly cited reference(s) follow.

Claim Objections

6. Claim 9 is objected to because of the following informalities: "description means", perhaps "decryption means" was intended. Appropriate correction is required.
7. ***This is not intended to be a complete list of informalities.***

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 25 is rejected under 35 U.S.C. 102(e) as being anticipated by Tagawa.

Regarding claim 25, Tagawa teaches

- a recording medium storing a computer-readable program for transferring encrypted content data from a data transfer apparatus having a first memory storing said encrypted content data to a second memory accommodated in a first external apparatus connected to said data transfer apparatus and a third memory accommodated in a second external apparatus connected to said data transfer apparatus, said computer-readable program comprising **(abstract, col. 9, lines 65-67, col. 10, lines 1-43)**:
- discriminating between said first external apparatus which can record only encrypted content data to said second memory and said second external apparatus which can record only decrypted content data to said third memory **(col. 11, lines 1-45)**;
- if said first external apparatus is discriminated decrementing a transfer count of the encrypted content data when transferring said encrypted content data from said first memory to said first external apparatus, incrementing said transfer count when said encrypted data are returned from said first external apparatus, and disabling the transfer of said content data from said first memory to said first external apparatus if said

transfer count has exceeded a predetermined limit value (**col. 11, lines 25-67, col. 12, lines 13-60**); and

- if said second external apparatus is discriminated, disabling the return of the encrypted content data from said second external apparatus (**col. 11, lines 25-45**).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa.**

Regarding claims 1, 9, and 17, Tagawa teaches

- a data transfer system having a data transfer apparatus and at least one of a first external apparatus and a second external apparatus which can be selectively connected to said data transfer apparatus, said data transfer apparatus comprising (**abstract**):
- transfer means for transferring content data encrypted in a predetermined manner from a first recording means which can store encrypted content data to said first external apparatus and said second external apparatus (**col. 9, lines 65-67, col. 10, lines 1-43**);

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- discrimination means for making discrimination between said first external apparatus which can record only encrypted content data to a second recording means accommodated in said first external apparatus connected to said data transfer apparatus and said second external apparatus which can record only decrypted content data to a third recording means accommodated in said second external apparatus connected to said data transfer apparatus (**col. 11, lines 1-45**); and
- if said first external apparatus is discriminated by said discrimination means, control means for decrementing a transfer count of the encrypted content data when transferring said encrypted content data from said first recording means to said first external apparatus, incrementing said transfer count when said encrypted content data are returned from said first external apparatus, and disabling the transfer of said content data from said first recording means to said first external apparatus if said transfer count has exceeded a predetermined limit value (**col. 11, lines 15-45**) and,
- if said second external apparatus is discriminated by said discrimination means, said control means disabling the return of the encrypted content data from said second external apparatus (**col. 11, lines 25-45**);
- said second external apparatus comprising:

- receiving means for receiving the content data encrypted in a predetermined manner from said transfer means (**col. 9, lines 65-67, col. 10, lines 1-43**);
- and recording means for recording said content data decrypted by said description means into said third recording means (**col. 10, lines 32-67**).

Tagawa does not expressly disclose decrypting said content data encrypted in a predetermined manner received by said receiving means. However, Tagawa does teach receiving encrypted information and encrypting/ decrypting means at the terminal and decrypting/ encrypting information received/ prior to send to card (**col. 23, lines 60-67, col. 24, lines 1-11**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt/decrypt data at every step during the receiving/sending in the system of Tagawa. One of ordinary skill in the art would have been motivated to perform such a modification to maintain end-to-end security and provide data integrity, confidentiality, and availability (**col. 33, lines 30-60**).

Regarding claims 2, 10, and 18, Tagawa teaches

- wherein said second recording means accommodated in said first external apparatus is a flash memory (**col. 2, lines 1-22**).

Regarding claims 3, 11, and 19, Tagawa teaches

- wherein said third recording means accommodated in said second external apparatus is a magneto-optical disk (**col. 2, lines 1-22**).

Regarding claims 4, 12, and 20, Tagawa teaches

- wherein said first recording means is a hard disk (**col. 10, lines 32-43**).

Regarding claims 5 and 13, Tagawa teaches

- wherein said second external apparatus has decryption means for decrypting the encrypted content data transferred from said data transfer apparatus, recording the content data decrypted by said decryption means into said third recording means (**col. 24, lines 59-67, col. 25, lines 1-35**).

Regarding claims 6, 14, and 21, Tagawa teaches

- first receiving means for receiving the encrypted content data and a control signal from a content server (**abstract, col. 10, lines 1-43**);
- second receiving means for receiving unencrypted content data from a package medium (**col. 11, lines 1-45**); and
- if said second external apparatus is discriminated by said discrimination means, determination means for determining whether or not to transfer said content data from said content server on the basis of said control signal attached to said content data supplied from said content server (**abstract, col. 10, lines 44-67**).

Regarding claims 7, 15, and 22, Tagawa teaches

- wherein said control means restricts the transfer count of said content data supplied from said content server, said content data being transferred from said first recording means to said second external apparatus (**col. 12, lines 12-60**).

Regarding claims 8, 16, and 23, Tagawa teaches

- first receiving means for receiving encrypted content data and a control signal supplied from a content server (**abstract, col. 10, lines 1-43**);
- second receiving means for receiving unencrypted content data supplied from a package medium (**col. 11, lines 1-45**); and
- encryption means for encrypting said unencrypted content data supplied from said package medium and received by said second receiving means (**abstract, col. 24, lines 32-67, col. 25, lines 1-16**);
- if said second external apparatus is discriminated by said discrimination means, transferring the content data encrypted by said encryption means to said second external apparatus (**abstract, col. 10, lines 44-67**).

Regarding claim 24, Tagawa teaches

- a data recording apparatus which receives encrypted content data from a data transfer apparatus having a first recording medium storing said encrypted content data and records the received encrypted content data to a second recording medium (**col. 9, lines 65-67, col. 10, lines 1-43**), comprising:
 - communication means for performing bidirectional communication with said data transfer apparatus (**col. 10, lines 1-43**);
 - recording means for recording said content data decrypted by said description means to said second recording medium (**abstract, col. 10, lines 1-43**); and

- control means for disabling the return of said content data from said second recording medium to said data transfer apparatus through said communication means (**col. 11, lines 25-45**).

Tagawa does not expressly disclose decrypting said encrypted content data supplied from said data transfer apparatus through said communication means and performing authentication with said data transfer apparatus through said communication means. However, Tagawa does teach receiving encrypted information and encrypting/decrypting means at the terminal and decrypting/encrypting information received/ prior to send to card (**col. 23, lines 60-67, col. 24, lines 1-11**) and authenticating parties to a communication (**col. 7, lines 60-67, col. 8, lines 1-42**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt/decrypt data at every step during the receiving/sending in the system of Tagawa and perform authentication of all/any parties/y to a communication exchange. One of ordinary skill in the art would have been motivated to perform such a modification to maintain end-to-end security and provide data integrity, confidentiality, and availability (**col. 33, lines 30-60**).

Conclusion

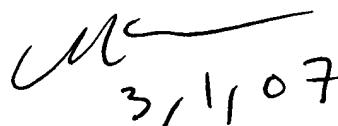
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DGC

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